

Docket CS03-036
S/N 10/743,596
Response to Office action dated 2005-03-03

REMARKS/ARGUMENTS

Examiner Owens is thanked for the thorough Office Action.

Restriction

In the instant office action, restriction was required to one of three stated
Inventions under 35 U.S.C. 121. The Inventions stated are :

- I. Claims 1-13, drawn to an ESD protection device, classified in class 257, subclass 173.
- II. Claims 14-25, drawn to a method of making an ESD protection device, classified in class 438, subclass 133.
- III. Claims 26 -- 33, drawn to a method of using an ESD protection device, classified in class 257, subclass 135.

Provisional election

Applicant provisionally elects to be examined on the Invention described by the Examiner as Group I - Claims 1-13, drawn to an ESD protection device, classified in class 257, subclass 173.

This election is made with traverse of the requirement under 37 C.F.R.1.143 for the reasons given in the following paragraphs.

Respectful Request To Reconsider The Requirement For Restriction Inventions I and II

The examiner is respectfully requested to reconsider the Requirement for Restriction given in the Office Action.

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MPEP 806.05(f) states:

806.05(f) Process of Making and Product Made - Distinctness

A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process.

Allegations of different processes or products need not be documented.

A product defined by the process by which it can be made is still a product claim (In re Bridgeford, 357 F.2d 679, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process; defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention.

If applicant convincingly traverses the requirement, the burden shifts to the examiner to document a viable alternative process or product, or withdraw the requirement.

The office action argues that:

"In the instant case the product as claimed can be made by another and materially different process, for example, the p-well can be formed in the n-well and deep n-well instead of forming the n-well and deep n-well to surround the p-well on the sides and bottom."

However, the applicant respectfully disagrees that 1) the above process is materially different and 2) the applicant's claim 14 covers the above alternative p-well process.

The Office Action's p-well process is not materially different that applicant's claimed process

The applicant's embodiment is a EDS device. The office Actions proposed materially different process is merely reversing the order of claim 14's steps (a) and (b). This is not a materially different process.

Applicant's claim 14 claims the above alternative p-well process. Claim 14 steps a and b read as follows:

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14. A method of forming an ESD protection device comprising:
 a) forming a n-doped region and a p-doped region in a p-well in a semiconductor structure; said n-doped region and said p-doped region are spaced;
 b) forming a n-well and a deep n-well that surround said p-well on the sides and bottom;

Patent law interprets method claims steps as being performed in any order, given that it is feasible to do so. Also, the specification does not state that step a has to be performed before step b. Furthermore, changing the order of steps a and b does not materially affect the embodiment. The specification clearly states that similar procedures are within the scope of the embodiments. See specification p. 20, Lines 13 to 19. Therefore, claim 14 covers claim 14 steps (a) and (b) in any order.

Inventions I and III

The office action, page 3, states:

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) **the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product for example, the ESD protection device can be used as a bipolar transistor in a conventional circuit structure.**

Applicant respectfully disagrees. The applicant's process is a ESD protection device that comprises a transistor as claimed. (See e.g., claim 1). However, the claimed ESD device has additional elements that are connected to the transistor. The Office action selects one element (transistor) of the entire (ESD) device and then posits that that element can be used as that element. (e.g., a transistor that is part of a device can be used as a transistor). The office

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action has not met the burden of "MPEP 806.05h) because the office action has not stated a materially different process for using the product (the "whole" claimed ESD device). In contrast, the office action has stated a same process for a sub-element of the claimed product.

In addition, the office action has not met the burden because the claimed transistor acts as a transistor in the claimed process of using the device.


Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of a second and third Patent Application upon the Applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

CONCLUSION

Withdrawal of the restriction requirement and the allowance of the present patent application is requested. Allowance of all claims is requested. Issuance of the application is requested.

It is requested that the Examiner telephone the undersigned attorney at (215) 670-2455 should there be anyway that we could help to place this Application in condition for Allowance.

Respectfully submitted,

 3/17/05

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